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10/084,527	02/27/2002	Robert C. Schikner	GRA2.PAU.03	7706

7590

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EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/084,527

Applicant(s)

SCHIKNER

Examiner

M. VARGAS

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 6/27/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-56 is/are pending in the application.
- Of the above claim(s) 1-23, 53 + 54 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 24-52, 55 + 56 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. Applicant's election of Group II, claims 24-52, 55 and 56 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Antonious

(see col. 2, lines 44-46 and 59-64).

The applied reference discloses the instant process for making a set of golf clubs/shafts with enhanced performance or playability by selecting weighting inserts or plugs of various weights and positioning them on existing clubs of a set, thereby anticipating claims 55 and 56.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 25, 27, 28, 30-32, 39, 40, 42, 43, 45 and 46 are rejected under 35 U.S.C.

103(a) as being unpatentable over Antonious.

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Antonious discloses making golf shafts and clubs of lightweight, composite material (col. 4, line 34--ie, the composites would reduce the overall weight of the club/shaft) and varying the swing weight of the resultant by attaching a weighted insert to the shaft. Note that the reference teaches that the insert can be placed in new shafts of new clubs or fitted onto an existing club/shaft.

Essentially, the applied reference fails to explicitly disclose that the swingweight provided would be that of a typical steel shafted club. However, it is made rather clear in Antonious that one of ordinary skill in the art would provide the insert in whatever position on the shaft and of whatever weight to optimize the performance of the resultant club. Hence, to make the lightweight club with a swingweight similar to that of a typical steel shafted club would have been obvious if the golfer using the club feels more comfortable with such a swingweight. The exact weight of the composite, the location of the balance point of the club, the weight and variance thereof of the plugs and the selection of golf head all would likewise have been well within the skill level of the art for optimal performance based on individual need and ability to swing the club.

4. Claims 26, 33-37, 41 and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antonious in view of Preece et al -557.

The primary reference discloses the basic claimed method as set forth in paragraphs 2 and 3, supra, lacking essentially that the golf club/shaft is one piece and that the balance point is selectively located by adding a dense (metal) material to the plug. Preece et al -557 discloses making a one-piece, composite golf club/shaft by wrapping plies around a mandrel, one of the plies being loaded with a metal powder to make same more dense and heavy, the effect being the

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same as that in Antonious--namely, to adjust the swing weight or balance point of the club. Given that the primary reference teaches to add the insert to new clubs, it would have been obvious to one of ordinary skill in the art to modify the method taught therein as shown in Preece et al -557 by making the shaft as one-piece. Also, one of ordinary skill, making a new shaft/club, would have found the utilization of a weighted composite ply as an obvious variant over using a metal insert.

5. Claims 29, 38, 44 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antonious in view of Preece et al -483.

Antonious discloses the basic claimed method lacking essentially the mandrel molding process wherein the insert/plug becomes unitary with the shaft and also fills a hole in the tip end of the shaft. Preece et al -483 discloses these features in the making of a composite golf shaft. Even though the secondary reference is not necessarily directed to making an adjusted swingweight club, it is submitted that Preece et al -483 constitutes analogous art in showing one of ordinary skill another method by which plugs or inserts would have been combined with plies which are wrapped around a mandrel and cured to form a composite golf shaft. On that basis, it would have been obvious to one of ordinary skill in the art to employ the mandrel molding method of Preece et al -483 as an expeditious way of combining the insert with a newly made golf shaft as generally taught in Antonious.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

July 23, 2003

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300

7/23/03